



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hohn et al.
Serial No. : 10/616,783
Filed : July 10, 2003
Title : WAVELENGTH-CONVERTING CASTING COMPOSITION AND LIGHT-
EMITTING SEMICONDUCTOR COMPONENT

Art Unit : 2826
Examiner : Minh Loan Tran

MAIL STOP RCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Applicants request consideration of the information below and the references listed on the attached PTO-1449 form. Under 37 C.F.R. § 1.98 (a)(2)(ii), only copies of foreign patent documents and/or non-patent literature are enclosed. Copies of any listed U.S. patents or U.S. patent application publications can be provided upon request. Also disclosed as part of this Information Disclosure Statement (IDS) are copies of communications from foreign patent offices regarding foreign counter-part applications.

U.S. Patent Nos. 6,066,861 ("the '861 patent"), 6,245,259 ("the '259 patent"), 6,277,301 ("the '301 patent"), 6,592,780 ("the '780 patent"), and 6,613,247 ("the '247 patent"), which are related to the present application and will be collectively referred to hereinafter as "the particle-size patents," are part of the following litigation in the United States District Court for the District of Columbia, specifically:

CITIZEN ELECTRONICS COMPANY, Ltd. vs. OSRAM GMBH and OSRAM
OPTO SEMICONDUCTORS GMBH – Case Number 1:05CV01560

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

10-17-05
Date of Deposit
Signature *Cheryl A. Canon*
CHERYL A. CANON
Typed or Printed Name of Person Signing Certificate

In its complaint (a copy of which is enclosed), Citizen alleges that the particle size patent are invalid. Citizen has not yet presented any evidence in the litigation in support of this allegation. This case was originally filed in the United States District Court for the District of Columbia as Case Number 1:05CV00112 (a copy of the complaint is enclosed); however, this earlier cases was dismissed.

The particle-size patents, which as noted above are related to the present application, are also part of a litigation before the United States International Trade Commission ("ITC"), specifically:

In the Matter of: CERTAIN LIGHT-EMITTING DIODES AND PRODUCTS
CONTAINING SAME – Investigation No. 337-TA-512

With regard to the ITC litigation, we submit a copy of the public version of the "Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond," a copy of the "Notice of Commission Final Determination of No Violation of Section 337 as to One Patent and Determination to Remand the Investigation as Certain Other Patents," and a copy of the public version of the "Commission Opinion."

During the ITC litigation, it was alleged, unsuccessfully, that: 1) the particle-size patents are invalid as indefinite because they fail to specify whether "mean grain diameter d_{50} " refers to a mean or a median, since d_{50} typically refers to a median; 2) the particle-size patents are invalid as indefinite because they fail to specify whether "mean grain diameter d_{50} " should be calculated by number, volume, length, or area; 3) the particle-size patents are invalid as indefinite because they fail to specify the instrument and/or methodology that should be used to measure "mean grain diameter d_{50} " of the phosphor particles; 4) the particle-size patents are invalid as indefinite because they fail to specify whether the grain diameter in "mean grain diameter d_{50} " is the volume spherical equivalent diameter, the projected area spherical equivalent diameter, or the Feret spherical equivalent diameter; 5) the asserted claims of the particle-size patents are obvious in view of U.S. Patent No. 5,998,925 ("Shimizu") in combination with the Phosphor Handbook by Shionoya and Yen; 6) the asserted claims are obvious in view of JP 04-137570 in

combination with the Phosphor Handbook; and 7) the asserted claims of the particle-size patents are obvious in view of JP 05-152609 in combination with the Phosphor Handbook.

The accused infringer did not pursue the obviousness allegations at trial, so the Court did not address these allegations further (see, page 56 from the Initial Determination.) With respect to the indefiniteness allegations, the administrative judge initially found the particle-size patents invalid because the words “mean” and “ d_{50} ” in the claim expression “mean grain diameter d_{50} ” were allegedly incompatible (see, for example, pages 29-40 and 56-57 from the Initial Determination). However, the ITC Commission later overruled this conclusion and found all claims valid (see pages 4-14 of the Commission Opinion). Additional documents further describing the invalidity allegations exist, however, they are filed with the ITC under seal.

In its Opinion, the ITC Commission also addressed claim construction, concluding that “mean grain diameter d_{50} ” should be calculated based on a volume-distribution for the particles (see pages 4-14 of the Commission Opinion.) For at least the reasons summarized in the Commission Opinion, applicants disagree with this construction and submit that “mean grain diameter d_{50} ” simply refers to the median particle diameter based on a number-distribution (i.e., half of the particles have a diameter greater than or equal to this diameter and the other half of the particles have a diameter less than or equal to this number.)

As noted above, the present application is related to the particle-size patents. Specifically, the present application claims priority to the application that issued as the ‘780 patent, which in turn claims priority to the application that issued as the ‘259 patent, which in turn claims priority to the application that issued as the ‘301 patent, which in turn claims priority to the application that issued as the ‘861 patent. Similarly, the ‘247 patent claims priority to the application that issued as the ‘301 patent. In addition, U.S. Patent Application Serial No. 10/623,819 was filed July 21, 2003 claiming priority to the application that issued as the ‘247 patent, and U.S. Patent Application Serial No. 09/731,406 filed December 6, 2000 claiming priority to the application that issued as the ‘301 patent. We note that in one or more of these applications, an Examiner may have taken a position different from that of the present Examiner. For example, in Serial No. 09/731,406 claims amended to remove a limitation to “epoxy” were rejected as allegedly failing to meet the written description requirement. We presume the present

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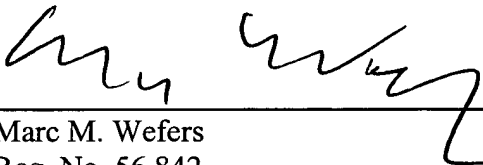
Attorney's Docket No.: 12406-006003 / 1997P2507 US
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Examiner has access to the file histories for these related applications should he wish to investigate such allegations further.

This filing is being made with the filing of a Request for Continued Examination. No fee is required.

Respectfully submitted,

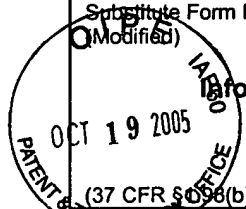
Date: 10/17/05



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| Substitute Form PTO-1449 (Modified)  (37 CFR § 1.98(b)) | U.S. Department of Commerce Patent and Trademark Office | Attorney's Docket No. 12406-006003 | Application No. 10/616,783 |
| | Information Disclosure Statement by Applicant (Use several sheets if necessary) | | |
| | Applicant Hohn et al. | | Group Art Unit 2826 |
| | | Filing Date July 10, 2003 | |

| U.S. Patent Documents | | | | | | | |
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| Examiner Initial | Desig. ID | Document Number | Publication Date | Patentee | Class | Subclass | Filing Date If Appropriate |
| | AA | 2,096,693 | 10/1937 | Cox | | | |
| | AB | 2,192,869 | 03/1940 | Pearce | | | |
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| | AR | 5,479,050 | 12/26/1995 | Pritchard et al. | | | |
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| | AT | 5,545,386 | 08/13/1996 | Kaneyoshi et al. | | | |
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| | AAA | 6,180,029 | 01/2001 | Hampden-Smith et al. | | | |

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| Examiner Signature | Date Considered |
| EXAMINER: Initials citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | |

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| Substitute Form PTO-1449 (Modified) Information Disclosure Statement by Applicant (Use several sheets if necessary) (37 CFR §1.98(b)) | U.S. Department of Commerce Patent and Trademark Office | Attorney's Docket No. 12406-006003 | Application No. 10/616,783 |
| | Applicant Hohn et al. | | |
| | Filing Date July 10, 2003 | Group Art Unit 2826 | |

| U.S. Patent Documents | | | | | | | |
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| Examiner Initial | Desig. ID | Document Number | Publication Date | Patentee | Class | Subclass | Filing Date If Appropriate |
| | BA | 6,245,259 | 06/12/2001 | Höhn et al. | | | |
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| | BH | 6,666,993 | 12/23/2003 | Milewski | | | |
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| Examiner Signature | Date Considered |
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| | CJ | 97/48138 | 12/18/1997 | WIPO | | | | |
| | CK | | | | | | | |
| | CL | | | | | | | |

| Other Documents (include Author, Title, Date, and Place of Publication) | | |
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| Examiner Initial | Desig. ID | Document |
| | CM | Möllmer et al., "Siemens SMT TOP-LED for Surface Mounting", <u>Siemens Components</u> , Bd. 26, No. 6, pp. 193-196 (1991) |
| | CN | Translation of Japanese Office Action Dated June 2, 2005 |
| | CO | Notice of European Opposition Dated September 15, 2003 |
| | CP | Notice of European Opposition Dated February 28, 2005 |
| | CQ | Six European Search Reports dated May 25, 2005 |
| | CR | <i>In the Matter of Certain Light-Emitting Diodes and Products Containing Same</i> , Investigation No. 337-TA-512, "Notice of Commission Final Determination of No Violation of Section 337 as to One Patent and Determination to Remand the Investigation as Certain Other Patents," Dated August 10, 2005 |
| | CS | <i>In the Matter of Certain Light-Emitting Diodes and Products Containing Same</i> , Investigation No. 337-TA-512, "Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond," (Public Version), Dated May 10, 2005 |

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| Other Documents (include Author, Title, Date, and Place of Publication) | | |
|---|-----------|---|
| Examiner Initial | Desig. ID | Document |
| | DA | <i>In the Matter of Certain Light-Emitting Diodes and Products Containing Same</i> , Investigation No. 337-TA-512, "Commission Opinion," (Public Version), Dated August 29, 2005 |
| | DB | Summons and Complaint re: Citizen Electronics Company, Ltd. v. Osram GmbH and Osram Opto Semiconductors GmbH, Case Number 1:05CV01560 |
| | DC | Summons and Complaint re: Citizen Electronics Company, Ltd. v. Osram GmbH and Osram Opto Semiconductors GmbH, Case Number 1:05CV00112 |
| | DD | Office Action from the Korean Patent Office dated August 25, 2005 |
| | DE | A.S. Murphy et al., "Breaking the Boundaries of Jameson Cell Capacity" http://www.xstratatech.com/doc/jc_boundaries_en.pdf |
| | DF | Clive Washington, <i>Particle Size Analysis in Pharmaceuticals and Other Industries Theory and Practice</i> , Ellis Horwood Limited, (1992), pp. 18-23 |
| | DG | "Phosphor L175" <i>Phosphors</i> (6/1997) |
| | DH | "Lamp Phosphor Data Sheet", from Nichia Kagaku Kogyo K.K., (May 16, 1995) |
| | DI | "Representation of results of particle size analysis – Part 2: Calculation of average particle sizes/diameters and moments from particle size distributions", <i>International Standard, ISO 9276-2</i> , pp. 1-12 (2001) |
| | DJ | Robert H. Perry, Don W. Green, and James O. Maloney (eds.), <i>Perry's Chemical Engineers' Handbook Seventh Edition</i> , McGraw Hill (1997), pp. 20-5 – 20-6 |
| | DK | Shigeo Shionoya and William M. Yen (eds.), <i>Phosphor Handbook</i> , CRC Press, pp. 495-498 (1999) |
| | DL | Shigeo Shionoya and William M. Yen (eds.), <i>Phosphor Handbook</i> , CRC Press, pp. 733-776 (1999) |
| | DM | |
| | DN | |

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